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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kernoghan Brune Ltd.

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Serial No. 75/499,150

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Intellectual Property Law Group, PLLC for Kernoghan Brune  
Ltd.

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(David Shallant, Managing Attorney)

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Before Seeherman, Hairston and Chapman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Kernoghan Brune Ltd. has appealed from the final  
refusal of the Trademark Examining Attorney to register  
BLUE RUBY, with the word RUBY disclaimed, for goods  
ultimately identified as "jewelry, namely rings, earrings,  
necklaces, bracelets, and brooches, all without simulated

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rubies and all without blue gems.”<sup>1</sup> Registration has been refused pursuant to Sections 2(e)(1) and 2(a) of the Trademark Act, 15 U.S.C. 1052(e)(1) and 1052(a), on the grounds that applicant’s mark is deceptively misdescriptive and deceptive of its identified goods.

The appeal has been fully briefed.<sup>2</sup> Applicant had requested an oral hearing, but that request was subsequently withdrawn.

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<sup>1</sup> Application Serial No. 75/499,150, filed June 8, 1998, asserting a bona fide intention to use the mark in commerce, and claiming priority of December 8, 1997 based on a Canadian application. The goods were initially identified as “jewelry, namely rings, earrings, necklaces, bracelets, and brooches,” and the modifying language was added by applicant in an attempt to overcome the Examining Attorney’s refusals.

The application initially asserted a bona fide intention to use the mark in commerce, and claimed priority pursuant to Section 44(d) of the Trademark Act, based on a Canadian application filed on December 8, 1997. In the first Office action, mailed January 17, 1999, the Examining Attorney asked applicant whether it wished to rely on the foreign registration as well as its intent to use basis. In its response filed June 1, 1999, applicant stated that it wished to maintain both bases “for the time being.” The Examining Attorney, in the Office action mailed October 21, 1999, continued the requirement for a certified copy of the foreign registration issuing from the Canadian application. In responding to that action, on January 27, 2000, applicant made no mention of the Canadian registration, and instead asserted that the application was in condition for publication. The Examining Attorney apparently interpreted this as a withdrawal of the foreign registration basis, and issued a final Office action. Applicant never contended, in either the request for reconsideration filed on September 18, 2000, or the further response (treated by the Board as a request for remand) filed on August 27, 2001, or its appeal brief or reply brief, that it still sought to rely on the foreign registration basis as well. Accordingly, we agree with the Examining Attorney’s assumption that this basis was withdrawn.

<sup>2</sup> In its appeal brief applicant makes the statement that it is “willing to consider” further amending the goods description, and

We reverse the refusals of registration.

A mark is deceptively misdescriptive if it misdescribes the goods and the misdescription is plausible. See **In re Woodward & Lothrop Inc.**, 4 USPQ2d 1412 (TTAB 1987). The standard for determining whether a mark is deceptive under Section 2(a), as set out by the Court in **In re Budge Mfg. Co., Inc.**, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), is:

- 1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?

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has indicated a proposed description, and has also indicated that it would accept a variation of the description if one were proposed by the Board or the Examining Attorney. After an appeal is filed, the proper procedure, if an applicant wishes to offer an amendment to its identification of goods, is to file a request for remand along with the requested amendment. The Board would then decide whether the application should be remanded. Here, applicant has neither followed this procedure, nor has it even couched the suggested language as an actual amendment, but in the merely advisory terms that it would be "willing to consider" a further amendment. The Examining Attorney therefore, in his brief, made no mention of this inchoate request. Applicant is also advised that it is within the Examining Attorney's province to determine whether or not to accept an amendment, or suggest variations to an amendment which has been submitted. The Board does not examine applications. The Board's task is to consider only those issues before it on appeal, and determine the propriety of the refusals or requirements that the Examining Attorney has made final. Thus, no consideration has been given to the suggested possible amendment referenced in applicant's brief. We also point out that, even if applicant had filed a request for remand to have the amendment considered, no good cause for granting such a remand has been shown. In this connection, we note that applicant amended its identification of goods in the response filed January 31, 2000, and in the request for reconsideration filed September 18, 2000 (at the same time as it filed its notice of appeal), despite the fact that the acceptability of the identification has never been in issue.

2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?

3) If so, is the misdescription likely to affect the decision to purchase?

Thus, the question of whether the mark is deceptively misdescriptive must be answered with respect to each of the subject refusals.

There is no dispute that there is no such thing as a blue ruby gemstone. However, the Examining Attorney asserts that because the mark includes the word RUBY, consumers will believe, mistakenly, that applicant's jewelry contains rubies. We disagree. The mark is BLUE RUBY, not RUBY per se. Consumers are not likely to dissect the mark to focus on the word RUBY alone. Rather, the incongruous nature of BLUE RUBY, which is a contradiction in terms as it refers to a ruby gemstone which is blue and therefore does not exist (as the Examining Attorney says, is "chimerical"),<sup>3</sup> will cause consumers to view the mark as a whole.<sup>4</sup>

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<sup>3</sup> Applicant has submitted several dictionary entries which show that the very definition of a ruby gemstone is one with a red color. See, e.g., "the red variety of the mineral corundum; in its finest quality, the most valuable of gemstones" (The McGraw-Hill Dictionary of Scientific and Technical Terms); "a precious stone that is a red corundum" (Webster's New Collegiate Dictionary).

<sup>4</sup> We note that applicant has suggested that BLUE RUBY can mean other things than an imaginary gemstone, including a woman who is

Because there is no such thing as a blue-colored ruby gemstone, consumers are not likely to believe that the misdescription actually describes the goods. In other words, consumers will not believe that applicant's jewelry contains blue rubies because blue rubies do not exist.

The Examining Attorney argues that purchasers are not likely to know that there is no such thing as a blue ruby because, although this fact is made clear by the dictionary definitions, "the average prospective purchaser is not likely to have consulted dictionaries before going to the jewelry store." The Examining Attorney also asserts that "the average prospective purchaser may know that other gems, such as diamonds, come in various colors" and that "the average prospective purchaser may believe that manufacturers are capable of using advanced technology to alter the shade of a gem from its traditional color."

Brief, p. 4.

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sad, or a "man who has just shot someone and is having regrets" (referring to the fact that Ruby is the surname of the man who killed Lee Harvey Oswald), or "a city or town that is experiencing hard times" (referring to the geographic connotation of "Ruby" as the name of cities in NY, SC and AK, as well as Ruby Ridge, ID). Brief. p. 8. We agree with the Examining Attorney, however, that as the word "ruby" is used in this mark and in the context of jewelry items, the meaning most likely to be accorded to the word by consumers is that of the gemstone, and that the mark as a whole will be viewed as referring to an imaginary gemstone.

We are not persuaded by these arguments. Although the dictionary definitions make clear that the ruby gemstone is red in color, consumers do not need to consult a dictionary to know this. Rather, this fact is common knowledge. Indeed, "ruby" is the name of a color. See, definition of "ruby": adj., "of the color ruby," Webster's New Collegiate Dictionary, and "a deep red color, as in a wine," The Living Webster Encyclopedic Dictionary. Thus, average consumers would know that rubies are red, not blue. As for the argument that consumers may believe that manufacturers are altering the shade of rubies, this is pure speculation. The Examining Attorney has submitted no evidence to show that manufacturers are doing anything of this sort, such that consumers might believe, upon seeing the mark BLUE RUBY, that this might be the case. It is the Office's burden to show that a mark is deceptively misdescriptive and/or deceptive, and this burden cannot be met by mere speculation of what manufacturers might be doing, or what consumers might believe that manufacturers are doing.

Moreover, the Examining Attorney's arguments fail to recognize that applicant's identification of goods makes it clear that its jewelry does not include any blue gems. Therefore, even if a consumer were not aware of the fact that there are no blue rubies, or believed that science can

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do anything, including making rubies blue, such consumer would not, upon seeing the mark BLUE RUBY on applicant's goods, conclude that the jewelry contained "blue rubies" because the jewelry does not contain any blue gemstones.<sup>5</sup>

Because prospective purchasers are not likely to believe that applicant's jewelry contains "blue rubies, the mark BLUE RUBY is not deceptively misdescriptive under Section 2(e)(1) nor is it deceptive under Section 2(a). See **In re Cord Crafts Inc.**, 11 USPQ2d 1157 (TTAB 1989); **In re Simmons**, 192 USPQ 331 (TTAB 1976).

Decision: The refusals to register under Sections 2(e)(1) and 2(a) are reversed.

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<sup>5</sup> We do not suggest that our finding that BLUE RUBY is not deceptively misdescriptive or deceptive for applicant's jewelry is based on this restriction in the identification. We do not believe that any consumer is likely to believe that there is such a thing as a blue ruby or a ruby which has been artificially colored blue, but even if there were such an unknowledgeable person, it would not affect our decision. The question of whether something is deceptively misdescriptive or deceptive, just like the question of likelihood of confusion, must be based on the average purchaser for the goods, not the consumer who is extremely gullible or unaware.